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REMARKS

Claims 10 and 39-45 are currently pending in the subject application and are presently under consideration. Claims 10 and 45 are herein amended to clarify what applicants regard as the invention. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 39, 40, and 45 Under 35 U.S.C. §102(e)

Claims 39, 40, and 45 stand rejected under 35 U.S.C. §102(e) as being anticipated by Herrod *et al.* (US Patent 6,405,049). Withdrawal of this rejection is respectfully requested for at least the following reasons. Herrod *et al.* does not teach or suggest applicants' claimed invention.

For a prior art reference to anticipate, 35 U.S.C. §102 requires that "each and every element as set forth in the claim is found, either expressly or inherently, in a single prior art reference. In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999) (quoting *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2USPQ2d 1051, 1053 (Fed. Cir. 1987)).

The subject invention as claimed, recites features directed to an order *fulfillment* system that employs a vehicle with a tracking system to *deliver* ordered goods to customers. Independent claim 39 recites; a customer destination *for delivering a completed order*, and independent claim 45 recites a similar limitation. Such aspects of applicants' claimed invention as recited in the subject claims are not disclosed or suggested by Herrod *et al.* Rather, Herrod *et al.* teaches a cradle and a portable data device that are in wireless communication and allow for a minimum of processing and data storage capability at the front end of a shopping system; *e.g.*, a customer selects a terminal from a cradle and while moving about the retail outlet access points broadcast data to the terminal – such a system does not teach or suggest *delivery of a completed order* to the customer, as recited in applicants' claimed invention.

In view of the at least above comments it is readily apparent that Herrod *et al.* does not teach or suggest the subject invention as recited in; independent claim 39 (and

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claim 40 dependent therefrom), and independent claim 45. It is respectfully submitted that this rejection should be withdrawn.

II. Rejection of Claims 10 and 41-44 Under 35 U.S.C. § 103(a)

Claims 10 and 41-44 stand rejected under 35 U.S.C. § 103(a) as being obvious over Herrod *et al.* in view of Ross *et al.* (US Patent 5,859,628.) Withdrawal of this rejection is respectfully requested for at least the following reasons. Neither Herrod *et al.* nor Ross *et al.*, alone or in combination, teach or suggest applicants' claimed invention, let alone there being no motivation to combine the references as suggested other than *via* employment of applicants' specification as a 20/20 hindsight-based roadmap to achieve the purported combination.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) *must teach or suggest all the claim limitations*. See MPEP §706.02(j). The *teaching or suggestion to make the claimed combination* and the reasonable expectation of success *must be found in the prior art and not based on the Applicant's disclosure*. See *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). An examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done." *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (P.T.O.B.A.&I. 1993).

As explained *supra*, the subject invention as claimed recites features directed to an order *fulfillment* system that employs a vehicle with a tracking system to *deliver* ordered goods to customers. Independent claim 10 recites; a *delivery of completed order* by the motorized vehicle, and Herrod *et al.* does not teach or suggest such claimed features. Moreover, Ross *et al.* is directed to a personal onboard information system for use in a vehicle, and fails to make up for the aforementioned deficiencies of Herrod *et al.*

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Additionally, regarding the combination of references, assertions are made in the Office Action that;

“such modifications would make the system more practical and more effective [...] Therefore it would have been an obvious extension as taught by Herrod *et al.*”

Applicants' representative respectfully submits that such rationale proffered to combine the teachings is to achieve benefits identified in applicants' specification. It is respectfully submitted that this is an unacceptable and improper basis for a rejection under 35 U.S.C. §103. In essence, the Examiner is basing the rejection on the assertion that it would have been obvious to do something not suggested in the art because so doing would provide advantages stated in applicants' specification. This sort of rationale has been condemned by the CAFC; *See e.g., Panduit Corp. v. Dennison Manufacturing Co.*, 1 USPQ2d 1593 (Fed. Cir. 1987). As explained earlier, even if the references are combined, applicants' claimed invention does not result.

In view of at least the above, it is readily apparent that the combination of Herrod *et al.* and Ross *et al.* does not teach or suggest applicants' claimed invention, and rejection of claims 10, claims 42-44 dependent therefrom, and claim 41 that depends from independent claim 39 should be withdrawn.

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CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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